



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/987,404	11/14/2001	Takeshi Kamio	SH-0027US	7029

21254 7590 09/07/2006

MCGINN INTELLECTUAL PROPERTY LAW GROUP, PLLC  
8321 OLD COURTHOUSE ROAD  
SUITE 200  
VIENNA, VA 22182-3817

EXAMINER
----------

HOFFMANN, JOHN M

ART UNIT	PAPER NUMBER
----------	--------------

1731

DATE MAILED: 09/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/987,404

Applicant(s)

KAMIO ET AL.

Examiner

John Hoffmann

Art Unit

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-8,10-15,17 and 21-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-8,10-15,17 and 21-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3-8, 10-15 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 3 and 10: it is unclear what is meant by the range being with the 0.6-0.8 range. 0.5-0.9 is clearly not within the 0.6-0.8 range.

Claim 5 and 12: it is unclear what is meant by the range being within the range. Claim 1 refers to a "D" range (that is the range uses "D") but claim 5 refers to an "L" range. It is unclear whether this claim means that both ranges must be met, or something else.

The *selecting* and "based on" (see claim 4, line 2 and claim 6, line 2 for two examples – there are occurrences in the other claim) for reads on a nebulous mental step, conducted prior to the manipulative steps of the claimed process, hence rendering the present process claim unclear in meaning in scope. If applicant wishes to patent detail controls over the recited process, the process steps must be positively recited. See *Seagram & Sons Inc. vs Marzall*, 84 USPQ 180. In other words: it is unclear whether one can copy applicant's invention completely (without infringing) merely by using a determined range or any other range that is not selected or based on – but is otherwise in the 0.5D-0.9D range. It appears that applicant merely rephrased the

Art Unit: 1731

“predetermined” language with the intent to claim the same thing – a mental step – which can only be ascertained by mind reading –or so it would seem.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 6 and 13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

There is no support for the new limitation that the range is selected. Only the diameter is disclosed as being selected.

### ***Claim Rejections - 35 USC § 103***

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

Art Unit: 1731

not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 1, and 3- 7 and 21-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishikawa 5306322.

See how Ishikawa was previously applied.

For new claims 21-23: col. 3 of Ishikawa discloses the gases.

For claims 24-25: The arrows of figures 2-3 represent the claimed movements

Art Unit: 1731

Claims 8, 10-15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishikawa 5306322 in view of Antos 6289698.

See how Ishikawa is applied above and in the prior Office Action.

### ***Response to Arguments***

Applicant's arguments filed 19 July 2006 have been fully considered but they are not persuasive.

It is argued that Ishikawa does not teach sintering the glass material within the 0.5-0.9 range. Examiner disagrees for the reasons set forth in previous Office actions.

It is argued that Examiner erred because Ishikawa is enabled only for the purpose of Ishikawa's purpose, but not enabled for Applicant's purpose. Examiner disagrees. Applicant's admission was that no useful product is can be made. The admission is not limited directed to useful products of Applicant's purpose.

Applicant has submitted evidence purported to demonstrate "importance (and unexpected superior results)". Examiner could find nothing which indicate the results obtained were either important or unexpected. Thus the unsupported assertion of importance and unexpected results is not convincing. Assertions cannot take the place of evidence. Nor has applicant explained how/why the results were truly important and truly unexpected. Examiner doubts that one would find it truly unexpected to find out that one would tend to bump a preform against a heater when there is not much clearance between the preform and the heater. Nonetheless it is not the Office's

Art Unit: 1731

burden to show such is expected, rather the burden is entirely on applicant to show the result is unexpected.

There is no showing that the evidence of record offered for comparison demonstrates results that are truly unexpected and commensurate in scope with the claims. In this regards, none of the claims are limited to the invention of tests 1-2 of the affidavit. All the tests show that D is 400 mm. The claims are not limited to 400 mm. Perhaps it is merely the spacing of 30-0 mm which causes the problem. Perhaps for a 100 mm preform, or a 500 mm preform, the optimal range is different. Likewise perhaps the length of the preform is an issue. A short preform might only bump when the range is  $0.95D$  or greater.

Applicants have not met their burden of explaining how the results reported in the and affidavit can be extrapolated from the limited instances presented so as to be guaranteed as attainable through practicing the invention as broadly claimed.

Moreover, Applicants have not met their burden of establishing that the reported results would have been truly unexpected (or important) to a person of ordinary skill in the art. In this regard, it is noted that Applicant have not furnished any detailed data regarding the actual experiments run with different lengths of preforms and with different furnace openings and data regarding the results obtained thereby.

It is well established that the evidence relied on to establish unobviousness must be commensurate in scope with the claimed subject matter. See *In re Kerkhoven*, 626 F

Art Unit: 1731

2d. 846, 851, 205 USPQ 1069, 1072-1073 (CCPA 1980) and *IN re Clemens*, 622 F.2d 1029, 1035, 206 USPQ 289, 296 (CCPA 1980).

In other words: the claims cover all sizes of furnaces and all sizes of preforms. But applicant has only shown results regarding a single sized furnace and a single length (3000 mm) preform. Since the claims are not limited to 3000 mm preforms or 400 mm furnaces, the evidence is not commensurate in scope with the evidence.

In response to applicant's argument that *Antos* does not teach the range: one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the



Art Unit: 1731

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

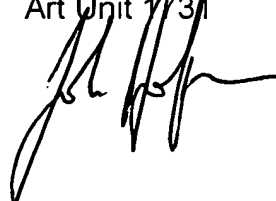
Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hoffmann whose telephone number is (571) 272 1191. The examiner can normally be reached on Monday through Friday, 7:00- 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

jmh

John Hoffmann  
Primary Examiner  
Art Unit 1731



31 Aug 2006